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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,454	11/20/2001	Thomas Wirycz	7189	2430

7590

03/09/2005

JOHNS MANVILLE INTERNATIONAL, INC.
Legal Department
P.O. Box 5108
Denver, CO 80217

EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,454

Applicant(s)

WIRYCZ ET AL.

Examiner

Jeremy R. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on December 15, 2004 has been entered. Claims 21 and 22 have been cancelled. Claims 23 and 24 have been added.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 8, 9, 14, 16, 19, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (U.S. Patent No. 5,876,551) in view of Melber (U.S. Patent No. 4,902,722).

Jackson discloses a breathable wallcovering with a printed design on at least one side (Abstract). The nonwoven fabric may be formed from glass fibers (column 4, line 33). The substrate is treated with a film or coating of a chemical dispersion that is a suitable plastisol (page 3, lines 21-35). The fabric is then dried and suitable ink may be used to provide a decorative pattern on the plastic layer (column 6, lines 16-36).

Jackson does not teach a second image coating that comprises polymeric binder and expandable chemicals. Melber teaches a syntactic foam material that can be applied to any suitable medium to provide graphic representations (column 2, lines 38-48), including wallcovers and fiberglass (column 7, lines 16-30). The foam of Melber comprises polymeric binder and expandable microspheres (column 3, lines 9-65). It

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would have been obvious to a person having ordinary skill in the art at the time of the invention to use the image coating step of Melber in addition to the processing steps of Jackson in order to provide a graphic representation to the wallcovering, as taught by Melber. With regard to claim 3, the chemical dispersion of Jackson may be applied continuously by rotary screen (column 5, lines 64-66). With regard to claim 8, the composite is dried in an oven, while exposed to air (column 6, line 17). With regard to claim 9, Jackson discloses a number of screening methods used to supply the ink (column 6, lines 29-30). With regard to claim 16, Melber discloses using acrylic latex binder (Example I). With regard to claims 17 and 18, Melber discloses adding various modifiers to the material (column 3, lines 24-28). Additionally, Melber discloses the foam must be stable (column 1, lines 33-37). It would have been obvious to a person having ordinary skill in the art at the time of the invention to add defoaming agent in order to better stabilize the expandable material, as desired by Melber. With regard to claim 19, Melber discloses the foam material includes pigment (column 3, lines 11-12). With regard to claim 20, Melber discloses using several different printing methods (column 6, lines 55-57). With regard to claim 23, Melber teaches the expansion takes place upon the application of heat (column 5, lines 1-5).

4. Claims 1-20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being obvious over Edlund (U.S. Patent No. 6,291,011) in view of Melber.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a)

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might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Edlund discloses a method of producing a fiberglass wallcovering similar to the present invention (claim 1). Edlund does not teach applying a second image coating of expandable material. Melber teaches a syntactic foam material that can be applied to any suitable medium to provide graphic representations (column 2, lines 38-48), including wallcovers and fiberglass (column 7, lines 16-30). The foam of Melber comprises polymeric binder and expandable microspheres (column 3, lines 9-65). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use the image coating step of Melber in addition to the processing steps of Edlund in order to provide a graphic representation to the wallcovering, as taught by

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Melber. With regard to claims 2-15, see the dependent claims of the Edlund reference. With regard to claim 16, Melber discloses using acrylic latex binder (Example I). With regard to claims 17 and 18, Melber discloses adding various modifiers to the material (column 3, lines 24-28). Additionally, Melber discloses the foam must be stable (column 1, lines 33-37). It would have been obvious to a person having ordinary skill in the art at the time of the invention to add defoaming agent in order to better stabilize the expandable material, as desired by Melber. With regard to claim 19, Melber discloses the foam material includes pigment (column 3, lines 11-12). With regard to claim 20, Melber discloses using several different printing methods (column 6, lines 55-57). With regard to claims 23 and 24, Melber teaches the expansion takes place upon the application of heat (column 5, lines 1-5).

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being obvious over Draxo et al. (U.S. Patent No. 6,337,104) in view of Melber.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application

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and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Draxo et al. disclose a method of producing a fiberglass wallcovering similar to the present invention (claim 1). Draxo et al. do not teach applying a second image coating of expandable material. Melber teaches a syntactic foam material that can be applied to any suitable medium to provide graphic representations (column 2, lines 38-48), including wallcovers and fiberglass (column 7, lines 16-30). The foam of Melber comprises polymeric binder and expandable microspheres (column 3, lines 9-65). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use the image coating step of Melber in addition to the processing steps of Draxo et al. in order to provide a graphic representation to the wallcovering, as taught by Melber. With regard to claims 2-15, see the dependent claims of the Draxo et al. reference. With regard to claim 16, Melber discloses using acrylic latex binder (Example I). With regard to claims 17 and 18, Melber discloses adding various modifiers to the material (column 3, lines 24-28). Additionally, Melber discloses the foam must be stable (column 1, lines 33-37). It would have been obvious to a person having ordinary skill in the art at the time of the invention to add defoaming agent in

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order to better stabilize the expandable material, as desired by Melber. With regard to claim 19, Melber discloses the foam material includes pigment (column 3, lines 11-12).

With regard to claim 20, Melber discloses using several different printing methods (column 6, lines 55-57). With regard to claims 23 and 24, Melber teaches the expansion takes place upon the application of heat (column 5, lines 1-5).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,291,011 to Edlund in view of Melber.

See the 35 USC 103 rejections set forth above in Section 4.

8. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,337,104 to Draxo et al. in view of Melber.

See the 35 USC 103 rejections set forth in above in Section 5.

Response to Arguments

9. Applicant's arguments filed December 15, 2004 have been fully considered but they are not persuasive.

10. Applicant argues there is no disclosure in Jackson or Melber that would motivate one of ordinary skill to apply a second design coating to the printed design already present on the surface of the wall covering of Jackson. However, Melber teaches the expandable foam may be applied to any medium (column 3, line 10), including wall coverings (column 7, lines 22-23). Nothing in the art precludes applying two design patterns. Melber teaches selective applications of the foam (column 6, line 42), so the foam need not be applied in a manner that renders the first design coating obsolete. Both design coatings would still be visible upon a selective application. Jackson also teaches printing a design pattern repeatedly to vary color and designs (column 6, lines 30-32), so Jackson does contemplate the use of more than one printed design pattern.

11. Applicant argues the expandable formulation of Melber provides a three-dimensional layer, which is incompatible with Jackson because Jackson provides a smooth-surfaced wall covering. However, Jackson is not limited to a smooth surface wall covering. Jackson discloses the wall covering may be embossed to provide an aesthetically pleasing texture (column 6, lines 38-40). Embossing would alter the smooth surface, giving it a three-dimensional character. Therefore, Melber's teachings are not incompatible with the wall covering of Jackson because the coating of Melber would also provide a three-dimensional character, but in a different manner.

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12. Applicant argues that the applying the coating layer of Melber to the plastisol layer of Jackson would likely cover the minute discontinuities and render the wall covering inoperative by not allowing the passage of water vapor. However, Melber teaches the coating may be applied in selective applications (column 6, line 42). A selective coating would not cover all minute discontinuities in the wall covering of Jackson, and the wall covering would still maintain its desired permeability.

13. Applicant argues that Edlund and Draxo et al. are disqualified as prior art under 35 USC 103 because the references are commonly owned by the assignee of the present application. However, the Edlund and Draxo et al. patents have a different inventive entity than the present application, so the references qualify as 102(e) art. See MPEP § 2136.04 [R-1].

14. Applicant argues that a Terminal Disclaimer obviates the Double Patenting rejections. However, no Terminal Disclaimer is found in the Application file, so the Double Patenting rejections are maintained.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

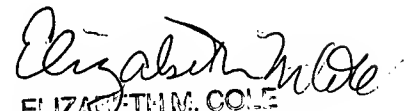
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRP

Jeremy Pierce
February 25, 2005


ELIZABETH M. COLE
PRIMARY EXAMINER